

Attorney Docket No. 9066-23DV

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Marsh et al.
Serial No.: 10/820,186
Filed: April 7, 2004
For: CUSHIONING DEVICE FOR FURNITURE

Confirmation No.: 7421
Group Art Unit: 3676
Examiner: Carlos Lugo

November 6, 2007

Mail Stop Appeal Brief -Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.67

Sir:

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed September 7, 2007 and responsive to the Notice of Panel Decision from Pre-Appeal Brief Review dated October 3, 2007.

Real Party In Interest

The real party in interest is assignee Tenn-Tex Plastics, Inc.

Related Appeals and Interferences

Appellants are aware of no appeals or interferences that would be affected by the present appeal.

Status of Claims

Claims 1, 4-11, 13 and 14 are pending and stand rejected. Appellants appeal the final rejection of Claims 1, 4-11, 13 and 14 by the Final Office Action dated May 7, 2007 (the Action). Claims 1, 4, 6-11, 13 and 14 were rejected in the Final Action under Section 103(a) as obvious over U.S. Patent No. 3,952,455 to McAlarney (McAlarney). Claims 1, 4 and 6-11 were rejected in the Final Action under Section 103(a) as obvious over U.S. Patent No. 2,185,161 to Tinnerman (Tinnerman) in view of U.S. Patent No. 1,998,791 to Schanz

(Schanz). Claim 13 was rejected in the Final Action under 35 U.S.C. 103(a) as being unpatentable over Tinnerman in view of Schanz and in further view of U.S. Patent No. 6,148,584 to Wilson ("Wilson"). Claim 5 was rejected in the Final Action under Section 102(b) as being anticipated by U.S. Patent No. 2,858,583 to McEvoy (McEvoy) and under Section 103(a) as being unpatentable over McAlaraney in view of McEvoy.

Status of Amendments

The Appendix of Claims submitted herewith reflects the state of the claims of record. No amendments have been filed subsequent to the Final Action.

Summary of Claimed Subject Matter

Claim 1 recites an article of furniture including first and second confronting furniture components. One of the first and second furniture components includes a frame and the other of the first and second furniture components includes a movable member connected with the frame and movable from an open position to a closed position (as illustrated, *e.g.*, in **Figure 6** with respect to the frame **52** and the door **53**; specification, page 7 lines 10-18). A device for protecting the first and second confronting furniture components includes a base member having opposite first and second faces (*e.g.*, as illustrated in **Figures 4-6** with respect to the base member **32**; specification page 6, lines 26-27). The first face is adapted to contact the first furniture component (*e.g.*, specification, page 7, lines 14-18). The base member has a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member (*e.g.*, as illustrated by the projection **150** in **Figures 4-6**; specification, page 7, lines 14-18). The projection is adapted to contact the second furniture component as it confronts the first furniture component (*e.g.*, **Figures 3** and **6**; specification, page 7, lines 31-32). A clip is connected to the base member (*e.g.*, **Figures 2-7**; specification, page 6, lines 16-22; page 7, lines 10-18; page 8, lines 10-21). The clip has a first member attached to one end portion of the base member and a second member attached to the first member (*e.g.*, as illustrated with respect to the panel **34** and the hook **37** in **Figures 4-6**; specification, page 7, lines 10-18). The base member, first member, and the second member define a cavity within which one of the first or second furniture components is captured to affix the device thereto (*e.g.*, **Figures 4-6**; specification, page 7, lines 10-18).

The device is formed as a unitary member and is entirely formed of a polymeric material (*e.g.*, **Figures 4-6**; specification, page 5, lines 28-31).

Claim 5 recites a device for protecting first and second confronting furniture components (as illustrated, *e.g.*, in **Figure 6** with respect to the frame **52** and the door **53**; specification, page 7 lines 10-18). The device includes a base member having opposite first and second faces (*e.g.*, as illustrated in **Figures 4-6** with respect to the base member **32**; specification page 6, lines 26-27). The first face is adapted to contact the first furniture component (*e.g.*, specification, page 7, lines 14-18). The base member has a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member (*e.g.*, as illustrated by the projection **150** in **Figures 4-6**; specification, page 7, lines 14-18). The projection is adapted to contact the second furniture component as it confronts the first furniture component (*e.g.*, **Figures 3** and **6**; specification, page 7, lines 31-32). The projection has a convex portion extending outwardly from the second face of the base member and a planar portion opposite the convex portion, and the planar portion of the projection has a thickness that is less than the thickness of the base member (*e.g.*, specification, page 5, lines 14-16).

Claim 13 recites an article of furniture including first and second confronting furniture components and a device for protecting the first and second confronting furniture components (as illustrated, *e.g.*, in **Figure 6** with respect to the frame **52** and the door **53**; specification, page 7 lines 10-18). The device includes a base member having opposite first and second faces (*e.g.*, as illustrated in **Figures 4-6** with respect to the base member **32**; specification page 6, lines 26-27). The first face is adapted to contact the first furniture component (Specification, page 7, lines 14-18). The base member has a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member (as illustrated by the projection **150** in **Figures 4-6**; specification, page 7, lines 14-18). The projection is adapted to contact the second furniture component as it confronts the first furniture component (*e.g.*, **Figures 3** and **6**; specification, page 7, lines 31-32). The base member has a planar portion extending away from the cushioning projection on opposite sides thereof (*e.g.*, **Figure 1**, specification, page 5 lines 10-16). A clip is connected to the base member (*e.g.*, **Figures 2-7**; specification, page 6, lines 16-22; page 7, lines 10-18; page 8, lines 10-21). The clip has a first member attached to one end portion of the base member and a second member attached to the first member (*e.g.*, as illustrated with

respect to the panel 34 and the hook 37 in **Figures 4-6**; specification, page 7, lines 10-18). The base member, first member and second member define a cavity within which one of the first or second furniture components is captured to affix the device thereto (*e.g.*, **Figures 4-6**; specification, page 7, lines 10-18). The device is entirely formed of a single material (*e.g.*, **Figures 4-6**; specification, page 5, lines 28-31).

Grounds of Rejection to be Reviewed on Appeal

1. Whether Claims 1, 4, 6-11, 13 and 14 are properly rejected under § 103(a) as being obvious over McAlarney.
2. Whether Claims 1, 4 and 6-11 are properly rejected under § 103(a) as being obvious over Tinnerman in view of Schanz.
3. Whether Claim 13 is properly rejected under § 103(a) as being unpatentable over Tinnerman in view of Schanz and in further view of Wilson.
4. Whether Claim 5 is properly rejected under § 102(b) as being anticipated by McEvoy.
5. Whether Claim 5 was properly rejected under § 103(a) as being unpatentable over McAlarney in view of McEvoy.

Argument

I. Introduction

A. Anticipation under 35 U.S.C. § 102

With respect to anticipation under 35 U.S.C. § 102, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *See* M.P.E.P. § 2131.

B. Obviousness under 35 U.S.C. § 103

As stated in the Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.* (M.P.E.P. §2141), a question regarding whether a claimed invention is obvious under 35 U.S.C. § 103 must include an analysis of the factors set forth in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)), which are described by the Supreme Court in the *KSR* decision to be 1) determining

the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art (hereinafter, the "*John Deere* factors"). The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. M.P.E.P. § 2143. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007). A Court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 13. When it is necessary for a Court to look at interrelated teachings of multiple patents, the Court must determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *Id.* at 14.

As discussed in more detail below, Appellants submit that the present rejections should be reversed because the cited art does not disclose various elements recited in the claims, and there are no reasons to modify the references as proposed by the Examiner.

II. Claims 1, 4, 6-11, 13 and 14 are patentable over McAlarney under Section 103.

Claims 1 and 13 recite that the first and second members of the clip define "a cavity within which one of the first or second furniture components is captured to affix the device thereto."

McAlarney proposes a resilient, honey-comb gasket for refrigerator doors. *See* McAlarney, Abstract. The Examiner identifies elements 21, 23 and 25 of McAlarney as equivalent to the clip (*see* the Action, page 3). In response to the arguments in Applicants' Paper dated October 25, 2006, the Action states that McAlarney "clearly discloses a frame (1) having a movable member (2) connected to the frame." *See* the Action, page 10. The elements 1, 2, 21, 23 and 25 of McAlarney are illustrated in Figures 1-2 reproduced below.

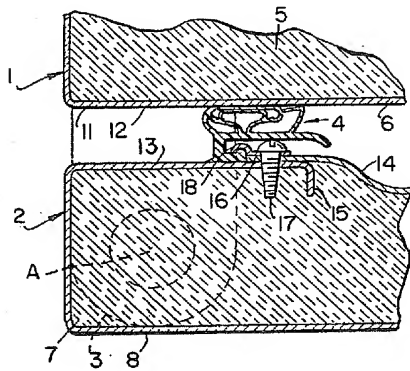


FIG. 1

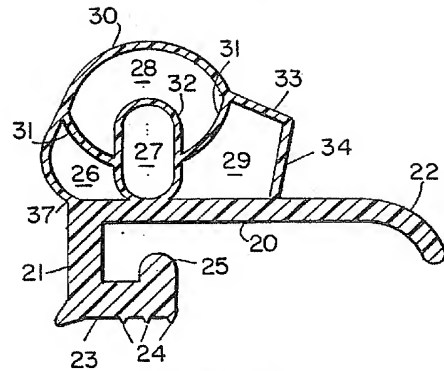


FIG. 2

Appellants submit that the Examiner's analysis of the scope and content of the prior art outlined above ignores significant differences between the claimed invention and the prior art. Therefore, the Examiner has not properly ascertained the differences between the claimed invention and the prior art as required by the second of the *John Deere* factors. In particular, the elements **21**, **23** and **25** do not capture the cabinet 1 or door 2, which are identified by the Examiner as furniture components (See **Figures 1 and 2** of McAlarney above). Therefore, the elements **21**, **22** and **25** clearly do not define "a cavity within which one of the first or second furniture components is captured to affix the device thereto" as recited in Claim 1 and 13.

Moreover, there are no reasons to modify the elements **21**, **23** and **25** so that the elements **21**, **23** and **25** would meet the recitation to define "a cavity within which one of the first or second furniture components is captured to affix the device thereto," even if the level of ordinary skill in the pertinent art were shown to be high under the third of the *John Deere* factors. As shown in **Figure 1**, the elements **21**, **23** and **25** are held by a screw **17** between the cabinet **1** and the door **2**. The elements **21**, **23** and **25** act to cushion the closing of the refrigerator door **1**, to seal against the passage of air and to provide a heat barrier after the door **2** is closed. See McAlarney, col. 4, lines 46-49. Appellants submit that it is unclear how these elements could be modified to capture a furniture component, and notably, the Examiner has provided no reason why one of skill in the art would modify elements **21**, **23** and **25** to define "a cavity within which one of the first or second furniture components is captured to affix the device thereto" as recited in Claims 1 and 13. As noted above, the key

to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. M.P.E.P. § 2143.

Therefore, McAlarney does not teach or render obvious all of the recitations of independent Claims 1 and 13 as required by § 103, and Appellants request that the rejections of Claims 1, 4, 6-11, 13 and 14 be reversed.

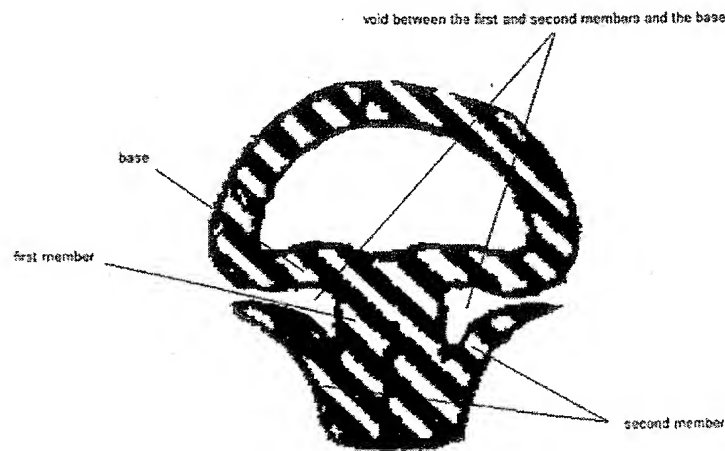
III. Claims 1, 4 and 6-11 are patentable over Tinnerman and Schanz under Section 103.

Independent Claim 1 recites, in part:

a clip connected to the base member, the clip having a first member attached to one end portion of the base member and a second member attached to the first member, the base member, first member and second member defining a cavity within which one of the first or second furniture components is captured to affix the device thereto...

The Examiner concedes that Tinnerman does not disclose a clip connected to the base member; however, the Examiner takes the position that the projection 15 of Schanz is equivalent to the claimed clip member.

Attachment #2 (reproduced below) was provided by the Examiner in the Action. In response to Applicants' Paper filed October 25, 2006, the Examiner states that Schanz discloses a first member connected to the base member and a second member connected to the first member with reference to Attachment #2. However, Claim 1 recites that the first member is "attached to one end portion of the base member."



Attachment #2

In contrast, the "first member" identified in Attachment #2 by the Examiner's notations extends from the middle portion of the element identified as the base, and therefore, is clearly not attached to one end portion of the base member as recited in Claims 1 and 13. This feature is also not disclosed by Tinnerman (which the Examiner concedes does not disclose a clip). Appellants submit that the Examiner's analysis of the scope and content of the prior art ignores this difference between the prior art and the invention recited in Claims 1 and 13 as required under the *John Deere* factors.

In addition, Appellants submit that is no reason why the sealing strip of Schanz would be modified so that the first member of the clip would be attached to one end portion of the base member, even if the level of ordinary skill in the pertinent art were shown to be high under the third of the *John Deere* factors. The Examiner has provided no reason why one of skill in the art would modify Schanz and/or Tinnerman in this manner.

Therefore, Tinnerman and Schanz do not teach or render obvious all of the recitations of independent Claim 1 as required by § 103, and Appellants request that the rejections of Claims 1, 4 and 6-11 be reversed.

IV. Claim 13 is patentable over Tinnerman in view of Schanz and in further view of Wilson under Section 103.

Independent Claim 13 recites, in part:

a clip connected to the base member, the clip having a first member attached to one end portion of the base member and a second member attached to the first member, the base member, first member and second member defining a cavity within which one of the first or second furniture components is captured to affix the device thereto...

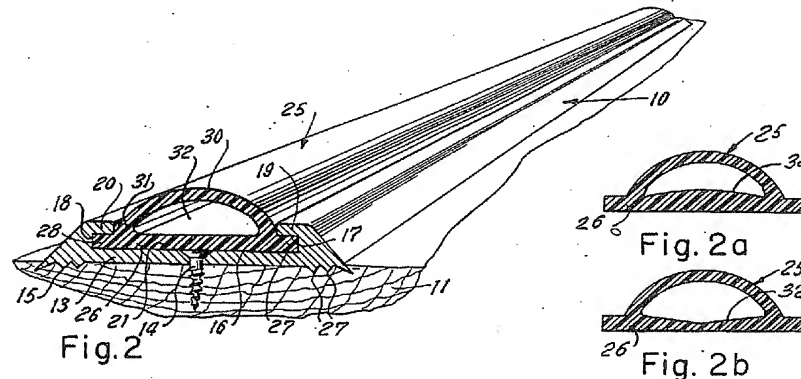
As noted above, Tinnerman and Schanz do not teach or render obvious a clip having a first member attached to one end portion of the base member. This feature is also not disclosed by Wilson (which the Examiner cites as allegedly teaching a planar portion extending away from the cushioning projection)

Therefore, Tinnerman, Schanz and Wilson do not teach or render obvious all of the recitations of Claim 13 as required by § 103, and Appellants request that the rejection of Claim 13 be reversed.

V. Claim 5 is patentable over McEvoy under Section 102.

Claim 5 recites "a planar portion opposite the convex portion [of the cushioning projection], and the planar portion of the projection has a thickness that is less than the thickness of the base member." The Examiner takes the position that McEvoy teaches a planar portion that has either the same thickness (**Figure 2**), more thickness (**Figure 2a**) or less thickness (**Figure 2b**). See the Action, page 7.

In response to Applicants' arguments in the Paper of October 25, 2006, the Examiner states that "the claim language does not require that [the base member planar portion] is planar from one end to the other so as to maintain the same thickness." See the Action, page 10. The Examiner identifies the weatherstrip seal member 25 as equivalent to the cushioning projection of Claim 5.



However, as illustrated in **Figures 2, 2a and 2b** above, no portion of the weatherstrip seal in McEvoy that is opposite the convex seal member 25 is planar (*i.e.*, flat) and has a thickness that is less than the thickness of the base member. As shown in **Figure 2b**, the portion of the weatherstrip seal 32 opposite the convex seal member 25 has a slope toward the center portion of the seal 32 and as such, is not planar.

Accordingly, McEvoy does not disclose all of the recitations of Claim 5 as required by § 102, and Appellants request that the rejection be reversed.

VI. Claim 5 is patentable over McAlarney in view of McEvoy under Section 103.

The Examiner concedes that McAlarney fails to disclose that the planar portion of the base member across the void has a thickness that is less than the thickness of the base member. The Examiner takes the position that McEvoy discloses this feature. However, as

discussed above, as illustrated in **Figures 2, 2a and 2b** of McEvoy, no portion of the weatherstrip seal in McEvoy that is opposite the convex seal member **25** is planar (*i.e.*, flat) and has a thickness that is less than the thickness of the base member.

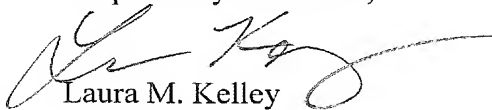
Appellants submit that the Examiner's analysis of the scope and content of the prior art ignores this difference between the invention recited in Claim 5 and McEvoy. Appellants submit that is no reason why the weatherstrip seal of McEvoy would be modified to provide a planar portion opposite the convex portion of the cushioning projection such that the planar portion of the projection has a thickness that is less than the thickness of the base member as recited in Claim 5, even if the level of ordinary skill in the pertinent art were shown to be high under the third of the *John Deere* factors. The Examiner has provided no reason why one of skill in the art would modify McEvoy in this manner.

Therefore, McEvoy and McAlarney do not teach or render obvious all of the recitations of Claim 5 as required by § 103, and Appellants request that the rejection of Claim 5 be reversed.

CONCLUSION

In view of the above discussion, Appellants submit that the rejection of Claims 1, 4-11, 13 and 14 should be reversed and the present application passed to issue.

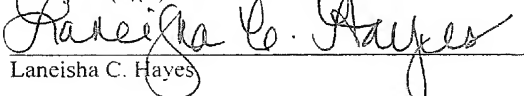
Respectfully submitted,


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CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4) to the U.S. Patent and Trademark Office on November 6, 2007.


Lancisha C. Hayes

Claims Appendix

1. (Previously Presented) An article of furniture, comprising:
first and second confronting furniture components, wherein one of the first and second furniture components comprises a frame and the other of the first and second furniture components comprises a movable member connected with the frame and movable from an open position to a closed position; and

a device for protecting the first and second confronting furniture components, the device comprising:

a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member, the projection adapted to contact the second furniture component as it confronts the first furniture component; and

a clip connected to the base member, the clip having a first member attached to one end portion of the base member and a second member attached to the first member, the base member, first member and second member defining a cavity within which one of the first or second furniture components is captured to affix the device thereto, wherein the device is formed as a unitary member and is entirely formed of a polymeric material.

2. – 3. (Canceled).

4. (Previously Presented) The article of furniture of Claim 1, wherein the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void.

5. (Previously Presented) A device for protecting first and second confronting furniture components, the device comprising:

a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection extending outwardly from the second face of the base member and covering and defining a void within the base member, the projection adapted to contact the second furniture component as it

confronts the first furniture component, wherein the projection has a convex portion extending outwardly from the second face of the base member and a planar portion opposite the convex portion, and the planar portion of the projection has a thickness that is less than the thickness of the base member.

6. (Previously Presented) The article of furniture of Claim 4, wherein the convex portion of the projection has a thickness that is less than the thickness of the base member.

7. (Previously Presented) The article of furniture of Claim 1, wherein the cushioning projection is elongated in a direction generally perpendicular to the thickness of the base member.

8. (Previously Presented) The article of furniture of Claim 1, wherein the cushioning projection is generally semi-circular.

9. (Previously Presented) The article of furniture of Claim 1, wherein the cushioning projection comprises an opening at at least one end.

10. (Previously Presented) The article of furniture of Claim 1, wherein the cushioning projection is closed at both ends.

11. (Previously Presented) The article of furniture of Claim 1, wherein the cushioning projection has a thickness of between about .020 and about .090 inches.

12. (Cancelled).

13. (Previously Presented) An article of furniture, comprising:
first and second confronting furniture components; and
a device for protecting the first and second confronting furniture components, the device comprising:

a base member having opposite first and second faces, the first face adapted to contact the first furniture component, the base member having a cushioning projection

extending outwardly from the second face of the base member and covering and defining a void within the base member, the projection adapted to contact the second furniture component as it confronts the first furniture component, the base member having a planar portion extending away from the cushioning projection on opposite sides thereof; and

a clip connected to the base member, the clip having a first member attached to one end portion of the base member and a second member attached to the first member, the base member, first member and second member defining a cavity within which one of the first or second furniture components is captured to affix the device thereto, wherein the device is entirely formed of a single material.

14. (Previously Presented) The article of furniture of Claim 13, wherein the projection has a convex portion extending outwardly from the second face of the base member and the base member has a planar portion opposite the convex portion across from the void.

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Evidence Appendix

NONE

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Related Proceedings Appendix

NONE